

Application No.: 10/053,030

Docket No.: BOHFLE 3.0-001

IN THE CLAIMS

1. (currently amended) A patch system comprising a plug made of polystyrene foam material sized and shaped to fit into a hole in a wall, ceiling or floor and to provide strength and support to the repaired area, the plug material affixed to an adhesive backing.

2. (cancelled)

3. (previously presented) The patch system of claim 2, wherein the plug material is fireproof.

4. (currently amended) The patch system of claim 2 1, wherein the adhesive backing includes paper and adhesive.

5. (previously presented) The patch system of claim 4, wherein the adhesive backing is self-adhesive.

6. (currently amended) The patch system of claim 2, wherein the plug is made from a foam material is sized to fit in holes having an opening between 1/4 inch and 6 inches.

7. (currently amended) A method of patching a hole in a wall, ceiling or floor comprising:

providing a patch system including a plug made of polystyrene foam affixed to an adhesive backing;

selecting a patch system having a plug sized and shaped to fit into the hole;

placing the plug in the hole; and

sealing the adhesive backing around the hole.

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8. (currently amended) The method of claim 7, wherein the plug is ~~made from a lightweight material~~ sized between  $\frac{1}{4}$  inch and 6 inches.

9. (cancelled)

10. (previously presented) The method of claim 7, further comprising sizing the plug to fit into the hole.

11. (previously presented) The method of claim 10, further comprising shaping the plug to fit in the hole.

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SUMMARY OF TELEPHONE INTERVIEW

The undersigned notes with appreciation the courtesies extended by Examiner Zirker during the brief telephone interview on May 5, 2004. In the interview, the undersigned noted that Styrofoam® is a registered trademark of Dow Chemical Company and that placing the word in the claim may constitute improper use of the trademark. While the Examiner believed that the term may be generic and that the term should remain in the claim, he indicated that he might consider alternative language. No agreement was reached.

REMARKS

The Examiner rejected claims 1-11 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed. The Examiner also objected to the addition of certain matter to the specification such as the reference to "any material" and "lightweight foam material." Applicant has submitted substitute specification deleting these terms objected to by the Examiner. However, with regard to the terms "fireproof" and "pre-molded," the undersigned respectfully points out that these terms are in the original drawings. The undersigned also points out that the terminology "flexible, self-adhearing [sic] backing" also appear in the original drawing. In addition, the paragraphs have been renumbered, as suggested by the Examiner.

The written description inquiry is a factual one and must be assessed on a case-by-case basis. See MPEP Section 2163; *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1561, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991). In order to satisfy the written description requirement, the disclosure as originally filed does

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not have to provide verbatim support for the claimed subject matter at issue. See *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1570, 39 USPQ2d 1895, 1904 (Fed. Cir. 1996). Instead, "the written description requirement is satisfied by the patentee's disclosure of 'such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention.'" *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). Put another way, one skilled in the art, reading the original disclosure, must reasonably discern the limitation at issue in the claims. *Waldemar Link GmbH & Co. v. Osteonics Corp.*, 32 F.3d 556, 558, 31 USPQ2d 1855, 1857 (Fed. Cir. 1994).

As quoted in MPEP Section 2163, in *Vas-Cath*, the Federal Circuit held that "under proper circumstances, drawings alone may provide a 'written description' of an invention as required by § 112." 935 F.2d at 1565, 19 USPQ2d at 1118. Drawings constitute an adequate description if they describe what is claimed and convey to those of skill in the art that the patentee actually invented what is claimed. *Id.* at 1566, 19 USPQ2d at 1119. In *Vas-Cath*, the Federal Circuit reversed the district court's grant of summary judgment of invalidity of claims to a double lumen catheter having a combination of features. Specifically, the *Vas-Cath* court determined that drawings alone of a double lumen catheter from a parent design patent application provided sufficient written description to support claims directed to a catheter having a "return lumen diameter substantially less than 1.0 but substantially greater than 0.5 times the diameter of the combined lumens." *Id.* at 1566, 19 USPQ2d at 1119. In doing so, the court stated, "[c]onsideration of what the drawings conveyed to persons of ordinary skill in the art is essential." *Id.* The court concluded that the drawings conveyed with reasonable clarity to

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those of ordinary skill in the art that the patentee had invented the catheter recited in the claims.

Furthermore, as noted in MPEP Section 2163.05, the predecessor court to the Federal Circuit held that that a specification and claims that disclosed a "segmenting medium" as air or other gas inert to a liquid supported the limitation "inert fluid" added to the claims by amendment because the description of the properties and functions of the "air or other gas" would suggest to a person of ordinary skill in the art that the invention included the use of an "inert fluid" broadly. In *re Smythe*, 835 F.2d 1376, 1383 (CCPA 1973). In this case, the court posited a hypothetical to show how an applicant could later broaden the scope of his claims:

If the original specification of a patent application on the scales of justice disclosed only a 1-pound "lead weight" as a counterbalance to determine the weight of a pound of flesh, we do not believe the applicant should be prevented, by the so-called "description requirement" . . . from later claiming the counterbalance as a "metal weight" . . . [or a] "weight as a pound of feathers . . . because the description of the use and function of the lead weight as a scale counterbalance in the whole disclosure would immediately convey to any person skilled in the art the knowledge that the applicant invented a scale with a pound counterbalance weight, regardless of its composition.

*Id.*

In the instant patent application, the original specification discloses a Styrofoam® plug that provides strength and support to the damaged area (see original claim 1). Applicant respectfully submits that the disclosure a Styrofoam® plug for providing support or strength in a damaged area of a wall, floor or ceiling would convey to any person skilled in the art the knowledge that the applicant invented a plug made from any foam providing strength and support to the damaged area. However, in view of the fact the instant application is under

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final rejection and the Examiner indicated in the telephone conference that he would not allow a claim containing a broad recitation of a solid plug or a foam plug, applicant has included the phrase "polystyrene foam" in the claims to advance prosecution of the instant application. Applicant reserves the right to file a continuation application to pursue broader coverage of a claim directed to a plug made from a solid material affixed to an adhesive backing.

Applicant notes that "polystyrene foam" is synonymous with the trademark Styrofoam® that appeared in the original claim. Thus, by this amendment, applicant substitutes language that was inherent in the original claim. In support of this, applicant submits the Merriam-Webster Collegiate Dictionary definition of Styrofoam® as "trademark used for expanded polystyrene plastic." In addition, applicant submits the web page "What is STYROFOAM," provided by the owner of the trademark, Dow Chemical. This web page describes Styrofoam® as a polystyrene foam. Applicant also notes that under MPEP Section 2173.05(u), the use of a trademark in a claim may constitute improper use of the trademark. Applicant respectfully submits that a person skilled in the art would recognize that the terminology "polystyrene foam" is synonymous with Styrofoam®. Accordingly, applicant has added the generic description of Styrofoam® to the specification.

The Examiner rejected claims 1-11 as being obvious over *D'Alisa et al.* United States patent number 6,071,833, citing column 1, lines 35-43. *D'Alisa* discloses that the prior art utilizes a patch utilizing a center portion that is adhered to the wall by application of glue, joint compound or spackling paste. There is absolutely no disclosure or suggestion in this reference or any of the references of record of a patch system or method that utilizes a solid plug of foam material, and in particular polystyrene foam, affixed to an adhesive backing that provides strength or support to the damaged area. The cited

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reference fails to disclose every element of applicant's claimed invention. Accordingly, applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness, and the rejection should be withdrawn.

In view of the foregoing amendment and remarks, the application is believed to be in condition for allowance, and early notice to this effect is earnestly solicited. If allowance of this application may be expedited by resolution of simple issues through a telephone conference, the Examiner is welcome to call the undersigned.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: May 11, 2004

Respectfully submitted,

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## PATCH SYSTEM AND METHOD

## FIELD OF THE INVENTION

[0001] This invention relates to a patch for walls, ceilings and floors and a method for patching walls, ceilings and floors.

## BACKGROUND OF THE INVENTION

[0002] A common problem is the need to quickly and effectively repair a hole or damaged area in a wall, ceiling or a floor of a building such as a home, office or other structure. Existing methods are labor-intensive and expensive.

[0003] It would be advantageous to provide a patch system and methods for patching holes in walls, ceiling or floors that require less labor and materials than presently existing methods.

## SUMMARY OF THE INVENTION

[0004] According to one or more embodiments of the invention, a patch system is provided that includes a plug made of foamed polystyrene material including an adhesive backing. According to certain embodiments, a method of patching a hole is provided comprising at least selecting a patch system including a plug made of foamed polystyrene material and an adhesive backing, inserting the plug into the hole and applying the adhesive backing to the area surrounding the hole.

## BRIEF DESCRIPTION OF THE DRAWINGS

[0005] A more complete appreciation of the subject matter of the present invention and the various advantages thereof can be realized by reference to the following detailed description in which reference is made to the accompanying drawings.

[0006] Figure 1 is a perspective view of a patch system according to one embodiment of the present invention;



~~[0010]~~[0007] Figure 2 a top plan view of the patch system shown in Figure 1; and

~~[0011]~~[0008] Figure 3 is a side view of the patch system shown in Figure 1.

#### DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENTS

~~[0012]~~[0009] One or more embodiments of the present invention provide a patch system and method for patching holes in ceilings, walls and floors. Turning now to the drawings and particularly to Figures 1-3, a patch system is shown generally by reference numeral 10. The patch system 10 includes a plug material 12 adapted to be placed in a hole and an adhesive backing 14 in contact with the plug 12 such that the adhesive backing surrounds the periphery of the hole. ~~It will be understood that the~~The plug material 12 can be made of any suitable material, but preferably, ~~the plug 12 is made from a lightweight foam material such as Styrofoam®~~ which is the trademark for a polystyrene foam. According to certain preferred embodiments, the plug material 12 is fireproof. The plug material 12 is pre-molded, and the plug 12 can be sized in depth and shape to fit various sized holes. The adhesive backing 14 preferably includes a flexible material such paper with an adhesive backing or Mylar® film.

~~[0013]~~[0010] One or more embodiments of the invention solves a common problem in the construction and maintenance of buildings such as homes and offices. Given the simplicity and ease of use individuals in the plumbing, electrical, sheetrock trades as well as individuals can use the patch system according to the present invention.

~~[0014]~~[0011] As noted above, the patch system can be supplied in a variety of sizes. Examples of available sizes are from 1/2" up to and including 6". Each size also is made in a manner such that the patch system be easily modified and

or trimmed to precisely fit in different sized holes. Thus, each size is capable of being easily modified if necessary to fit the repaired hole precisely and quickly. According to one or more embodiments, the patch system can be easily applied to a damaged area using the self-adhesive backing. The patch system and method according to the present invention saves labor and time and also but allows the average homeowner to easily make the necessary repair.

~~[0015]~~[0012] The patch system according to one or more embodiments fills the need for a fast, quick, easy and permanent repair to any wall, ceiling and or flooring surface. In use, one would simply find the correctly sized patch for the hole that has to be repaired, peel the backing off the self adhesive material, and simply insert the plug in the center of the adhesive patch into the hole to be repaired. The self-adhesive backing attaches firmly to the surface surrounding the patched hole. The patch job can then be finished as necessary using spackling or finishing whatever material is desired for the particular surface. The patch system of the present invention is easily applied to the damaged area using the self-adhesive backing.

~~[0016]~~[0013] The patch system of the present invention has a self adhesive backing for easy use and a lightweight foam plug such as a ~~styrofoam~~<sup>®</sup> polystyrene foam plug in the center that can be easily shaped to precisely fit the damaged hole precisely. The present invention substantially reduces the time and labor required to patch holes in walls, ceilings and floors without having to replace the damaged area. Thus, according to one or more embodiments of the present invention a substantially one step repair patch system and method are provided. The plug material provides is strength and support to the repaired area. The patch system and method can be

used for any repair in all types of construction/carpentry, including but not limited to any wall, ceiling and or floor.  
~~[0017]~~[0014] Although the invention herein has been described with reference to particular embodiments, it is to be understood that these embodiments are merely illustrative of the principles and applications of the present invention. It is therefore to be understood that numerous modifications may be made to the illustrative embodiments and that other arrangements may be devised without departing from the spirit and scope of the present invention as defined by the appended claims and their equivalents.